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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,888	12/19/2001	Jeffrey G. Nowlin	020375-006500US	2318

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3629

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,888

Applicant(s)

NOWLIN

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-16,18-22 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 6-16, 18-22, 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1) The amendments to the claims, the claim cancellation and the presentation of new claims are acknowledged.

2) Applicant's arguments (as filed May 22, 2003) with respect to the rejections under 35 USC 102 as being anticipated by Long have been fully considered but they are not persuasive.

In response to Applicant's argument that Long does not show the newly added limitation: printing an identifier on one of the components after that they have been provided to the system and reading the identifier, one of the components (e.g. the web of paper 14) is first provided to the system and then the system prints an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40).

Applicant's arguments with respect to claims 1-2, 4, 7, 9, 12-14 and 23 (as being anticipated by Delfer, III) have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejection is necessitated by adding the limitations: printing an identifier on one of the components after that they have been provided to the system and reading the identifier.

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4) Claims 1-2, 4, 6-8, 10, 12, 15-16, 18-21, 27-28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Long (EP 0,621,563).

W.R.T. Claims 1, 15, 27 and 31:

Long discloses a method for producing and weighing a mailing unit, comprising:
determining a weight of each of the components and electronically storing its record (Fig. 2; databases 88, 90);
providing one of the components (e.g. the web of paper 14) to the system;
printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);
reading the identifier to determine the components of the mailing unit;
placing the inserts into the envelope (see Figs.); and
determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

Long also discloses a system for producing and weighing mailing units, comprising:

a controller having a processor and a memory containing the weight of each of the components (predetermined) (see Fig. 2);

a printer (as controlled by the controller 25) for printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

a reader (27, 66) for reading the identifier and providing the identifier to the controller;

a movable track (see Figs.);

a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);

a moving mechanism to move the inserts from the track and into an envelope;

and

wherein the controller determines the components of the mailing unit based on the identifier (see Fig. 2; the reader 27, 66 scans the identifier) and the weight of the mailing unit based on the weights of the components (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

W.R.T. Claims 2 and 4:

Long discloses the step of predetermining the components (see abstract; known weight of the components), and summing the weights of the components of the mailing unit using a processor prior to assembly of the mailing unit (see Figs.).

W.R.T. Claims 6-8, 10-12:

Long discloses:

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retrieving data from the memory and using the processor (86) to summing the weight;

wherein the inserts are held in groups (see Fig. 1b);

selecting inserts from their respective groups and placing them onto the track (see Fig. 1b); and

wherein one of the inserts comprises a charge card that is attached to a card carrier, and one of a group including: letters, advertisements, checks, PIN mailers, phone cards and maps.

W.R.T. Claims 16-21:

Long discloses:

an external storage device (see Fig. for 88, 90);

wherein the controller sums the weights of the components prior to assembly of the mailing unit;

wherein the controller sums the weights of the inserts as the inserts are placed onto the track;

wherein the inserts are selected from a group including statements, card carriers, cards and advertising information; and

a sorting mechanism to sort the mailing units into groups based on their weights (or how many inserts with known weight are inserted) such that proper postages could be printed on the envelopes in the same group.

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W.R.T. Claim 30:

the method includes printing under the control of the processor an identifier on a second one (letter, statement or envelope besides the first component) of the components forming the mailing unit, the identifier printed on the second component based on that of the first component.

W.R.T. Claims 28 and 32:

the first component is a card carrier for insertion into an envelope;
the second component is a card for attachment to the card carrier; and
the identifier is printed on the card carrier before having the card attached.

Claim Rejections - 35 USC § 103

5) Claims 1-2, 4, 7, 9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delfer, III (US 5,264,665) in view of Long.

W.R.T. Claim 1:

Delfer discloses a method for producing and weighing a mailing unit, comprising:
determining a weight of each of the components and electronically storing its record (see Fig. 1A);
placing the inserts into the envelope (col. 5, lines 60-68); and
determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (col. 4, lines 44-59).

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However, Delfer does not expressly disclose the method including:
printing an identifier on a section of the traveling web of paper; and
reading the identifier to determine the components of the mailing unit.

Long teaches, for a system and method for assembling a mailing unit, that the method includes:

printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40); and
reading the identifier to determine the components of the mailing unit.

Since Long and Delfer are both from the same field of endeavor, the purpose disclosed by Long would have been well recognized in the pertinent field of Delfer.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Delfer such that the system prints an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper; and reads the identifier to determine the components of the mailing unit, as taught by Long, for the purpose of tracking a web section printed in accordance with a given data record and selectively activating the insert feeders in accordance with the given record as being read from the printed identifier so as to provide a high speed system for preparing letters for the mails which would be particularly adapted for target mailings.

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W.R.T. Claims 2, 4, 7, 9 and 12-14:

Delfer discloses the steps of:

predetermining the components, and summing the weights of the components of the mailing unit using a processor prior to assembly of the mailing unit (Id.);

wherein the inserts are held in groups (col. 4, lines 10-16);

wherein one of the inserts comprises a financial statement, and one of a group including: letters, advertisements, checks, PIN mailers, phone cards and maps;

organizing the mailing units based on a postage weight classification (see Figs. 1C, 2);

marking and mailing units that are different in weights than their classification (Id.).

6) Claims 11, 22, 29 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Delfer, III.

W.R.T. Claims 11, 22, 29 and 33:

Long discloses the invention as cited above but does not specifically disclose the invention including the insert being financial statement, and classifying the mailing units based on their weight within a given group via a marking.

Delfer teaches, for a system for determining the weights of the mailing units, that the system includes:

the insert being a financial statement; and

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the device to classify the mailing units based on their weight within a given group (col. 6, clines 41-59).

Since Delfer and Long are both from the same field of endeavor, the purpose disclosed by Delfer would have been well recognized in the pertinent field of Long.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to include the financial statement as the insert and classify the mailing units based on their weight within a given group by using Long's existing printing means to mark those mailing units, as taught by Delfer, for the purpose of providing a computer directed system which accumulates and presents relevant data concerning mailing pieces sent and postage due.

W.R.T. Claims 34-35:

The modified Long discloses the invention as recited earlier but does not expressly disclose the invention including a second printer.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art, to include the second printer for printing an identifier on a second one of the components, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *Sr. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Conclusion

7) Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on February 25, 2002 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

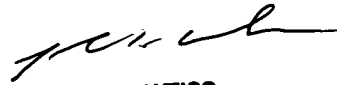
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
GAU 3629
August 8, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600